

U.S. Pat. App. No. 10/752,786

RESPONSEI. The 35 U.S.C. §103 Rejections

Claims 1-21 and 23-32 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2002/0193975 to Zimmerman ("ZIMMERMAN"). Applicant respectfully traverses the rejections.

It is axiomatic that the cited references in an obviousness rejection must disclose every element of the rejected claim.

A. Claim 1

Claim 1 recites a method for assisting navigation of digital content using a tangible medium, comprising:

receiving an instruction to access digital content corresponding to a portion of a tangible medium:

said medium being readable by a user-positionable input device, and
said digital content being accessible from a stored file;

determining and accessing stored digital content corresponding to said input device's instantaneous position on said tangible medium; and
enabling electronic navigation of said digital content including enabling toggling between browsing of said tangible medium and browsing of said digital content on a computer screen using said input device, said browsing of said digital content being performed using an input device without necessarily involving said tangible medium, wherein said browsing includes enabling a user to control translational or rotational movements as desired.

U.S. Pat. App. No. 10/752,786

1. Impermissible Hindsight Reconstruction

Improper hindsight reasoning should not be applied in support of an obviousness rejection. MPEP 2145.X.A. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *Interconnect Planning Corp. v. Feif*, 774 F.2d 1132,1141, 227 USPQ 543, 550 (Fed. Cir. 1985); *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553,220 USPQ 303,312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record conveyor suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher"). *Id.*

In the present office action, the Examiner acknowledged that ZIMMERMAN does not specifically teach the limitation: "browsing of said digital content being performed using an input device without necessarily involving said tangible medium." The Examiner has failed to cite another reference disclosing this limitation. Instead, the Examiner relied on personal knowledge in making the conclusory statement that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of ZIMMERMAN to include browsing the digital content without necessarily involving the tangible medium...." See page 5 of present office action.

Applicant respectfully submits that the Examiner has improperly applied impermissible hindsight reconstruction by using the claimed invention as an instruction manual to piece together the teachings of ZIMMERMAN and the Examiner's personal knowledge to render the claimed invention obvious.

Based on all the foregoing, Applicant respectfully submits that citing ZIMMERMAN in combination with the Examiner's own knowledge/conclusion was improper and requests the Examiner to withdraw the 103 rejections.

U.S. Pat. App. No. 10/752,786

2. ZIMMERMAN Failed to Disclose or Suggest the Step of Enabling a User to Control Translational or Rotational Movements as Desired

Even if the combination of ZIMMERMAN and the Examiner's personal knowledge were proper (which the Applicant respectfully traverses), ZIMMERMAN has failed to disclose or suggest at least one limitation in claim 1.

Claim 1 has been amended to recite the limitation of enabling a user to control translational or rotational movements as desired. This amended limitation has support on at least pages 7, 14 and 17 of the Specification¹.

ZIMMERMAN discloses a method to manipulate electronic media by manipulating off-line media. ZIMMERMAN, paragraph 22. Further, ZIMMERMAN discloses accessing pre-determined digital content by pointing a probe to various portions of a printed medium. In ZIMMERMAN, digital content to be retrieved and presented to a user are predetermined content previously associated with specific portions on the printed medium. Thus, a user in ZIMMERMAN does not have any free choice to browse the digital content (e.g., make translational movements, rotational movements, etc.).

ZIMMERMAN does disclose a zooming capability by turning a knob on the probe while pointing the probe to a specific portion on the printed medium. See ZIMMERMAN paragraphs [0081] and [0082]. Here again, the user does not have any free choice of "how" to browse the digital content.

In contrast, claim 1 recites a method that enables a user to toggle to a digital content browsing mode wherein the user can browse digital content without necessarily involving the tangible medium. Further, while in the digital content browsing mode, the user has free choice as to "how" he wishes to browse the content (e.g., make translational movements, rotational movements, etc.). A separate input device can be used to effectively browse digital content. Digital browsing mode can be initiated by toggling from tangible medium browsing mode to digital content browsing mode.

¹ This amendment merely makes explicit a limitation that was implicit in the claim and should not be subject this claim to the doctrine of prosecution history estoppel. See the Examiner's comment on page 22 of present office action.

U.S. Pat. App. No. 10/752,786

Based on the foregoing, Applicant respectfully submits that ZIMMERMAN does not anticipate claim 1 which is now in condition for allowance.

B. Claims 2-21 & 23-24

Claims 2-24 are dependent on claim 1. Based on the foregoing arguments regarding claim 1, these dependent claims should also be in condition for allowance. Claim 22 has been canceled.

C. Independent Claims 25, 28, 29 and 32

Independent claims 25, 28, 29 & 32 include a similar limitation as discussed above regarding claim 1. Thus, based on the foregoing arguments regarding claim 1, these claims should also be in condition for allowance.

D. Claims 26-27 & 30-31

Claims 26-27 & 30-31 are dependent on claims 25 and 29, respectively. Based on the foregoing regarding claims 25 & 29, these dependent claims should also be in condition for allowance.

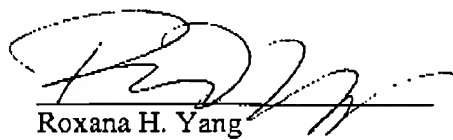
U.S. Pat. App. No. 10/752,786

III. Conclusion

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance. Should the Examiner believe that a telephone interview would help advance the prosecution of this case, the Examiner is requested to contact the undersigned attorney.

Respectfully submitted,

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